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EXAMINER

VILLECCO, JOHN M

ART UNIT

PAPER NUMBER

2612

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/891,562

**Applicant(s)**

MCINTYRE ET AL.

**Examiner**

John M. Villecco

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6,7 and 10-18 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7 and 10-15 is/are allowed.
- 6) ☒ Claim(s) 1-4,6 and 16-18 is/are rejected.
- 7) ☒ Claim(s) 6,10 and 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. On page 9 of the applicant's response applicant states that claim 5 has been amended to overcome the 112, 2<sup>nd</sup> paragraph rejection presented in the last office action. However, in the listing of the claims, it appears that claim 5 has been cancelled. For examination purposes it will be assumed that claim 5 has been cancelled.
2. Applicant has amended claim 16, to read "said digital medial (sic) file having a digital image file and an instruction icon with respect to said digital image file". This amendment appears to overcome the 35 USC 102(e) rejection presented for claim 16 in the previous office action.
3. Additionally, applicant has amended claim 1 to include the limitations of claim 5, to overcome the 35 USC 103 rejection from the previous office action. However, it is the opinion of the examiner that the limitations of claim 5 do not make the claim allowable. Clearly the camera of Safai includes a selection device to create an electronic content identifier to be associated with a digital image file. As mentioned in the previous office action, the address to which the image is to be sent is interpreted to be the electronic content identifier. Furthermore, as mentioned in the rejection of claim 5 in the previous office action, Goldberg discloses determining an image's content and then forwarding that image to a designated storage area. Although the image is not sent directly to an e-mail address, Goldberg teaches automatically forwarding an image based on the content that is determined to be in the image. The image is sent to a designated storage area set aside for the person identified in the image. Therefore,

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when used in combination with Safai, it would have been obvious to one of ordinary skill in the art at the time the invention was made to automate the image distribution system of Safai by automatically identifying a person in the image and sending the image to an email account so that a user does not have to personally identify who the image should be sent to, thereby enhancing the operation of the camera.

4. Additionally, applicant's amendment has brought up various 112 rejections and claim objections.

#### *Claim Objections*

5. Claims 6, 10, and 16 are objected to because of the following informalities:

- In line 5 of claim 16, applicant recites the phrase "said digital medial file". This appears to be a typographical error and that the applicant meant to use the phrase – said digital media file –.
- Claim 6 is dependent upon a cancelled claim 5. For examination purposes it will be assumed that claim 6 is dependent upon claim 4. Based upon this assumption, claim 6 raises some 112, 2<sup>nd</sup> paragraph issues as well. Please see the 112, 2<sup>nd</sup> paragraph rejection on the following pages.
- Claim 10 is dependent upon a cancelled claim 9. For examination purposes it will be assumed that claim 10 is dependent upon claim 7

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-4, 6, and 16-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Regarding claim 1, applicant recites the phrase “and determines that content identifier is present”. Claim 1 is directed toward the electronic camera as stated in the preamble. However, there is no mentioning the applicant’s specification that the camera determines if the content identifier is present. As discussed on pages 32 and 33 and Figure 21 of the applicant’s specification the images are transferred to the service provider where the service provider determines if the content identifier is present. Since the specification does not disclose that the camera is capable of determining if the content identifier is present, the claim is indefinite for failing to particularly point out and distinctly claim the subject matter that the applicant regards as the invention.

9. As for claim 4, applicant has added the limitation that the “transmission to said electronic includes information contained in said transmission to said recipient”. This claim language is hard to understand. Firstly, it appears that the newly added phrase “to said electronic” is incomplete. For examination purposes it will be assumed that the applicant meant to use the phrase “to said electronic camera”. Secondly, it is clear from the specification that information is transmitted from the camera, not to the camera. Therefore, applicant’s claim is definite for

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failing to particularly point out and distinctly claim the subject matter that the applicant regards as the invention.

10. Claim 6 recites the limitation "said predetermined image content" in line 2. There is insufficient antecedent basis for this limitation in the claim.

11. Claim 16 recites the limitation "said instructions" in line 8. There is insufficient antecedent basis for this limitation in the claim. More specifically, applicant has changed to the claim language to recite "an instruction icon". Then the applicant goes on to recite the phrase "said instructions". Since there was no previous mentioning of "said instructions", the claim is indefinite.

12. Claims 2, 3, 17, and 18 are rejected based on their dependency to claims 1 and 16, respectively.

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. **Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Safai (U.S. Patent No. 6,715,003) in view of Hull et al. (U.S. Patent No. 5,806,005) and further in view of Goldberg (U.S. Patent No. 2004/0008872).**

15. Regarding *claim 1*, Safai discloses an electronic camera (100) capable of capturing an image. The camera includes a communication port (214) for communicating data externally.

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Safai discloses transmitting images using a plurality of communication devices (col. 6, lines 6-21). The images are transmitted to a service provider (600) for distribution (col. 14, line 64 to col. 15, line 5). Furthermore, Safai discloses the ability to attach an address to the image which the service provider processes and uses to send the image to the correlated destination (col. 8, lines 37-60). The address attached to the image and sent to the service provider is interpreted to be the electronic content identifier.

Safai, however, fails to specifically disclose wirelessly communicating the image to the recipient using a cellular modem. Hull, on the other hand, discloses that it is well known in the art to use a cellular modem to transmit images wirelessly to a service provider. More specifically, Hull discloses a modem (26) and a cellular telephone transmitter (28) for sending the images captured by the camera through a cellular system (16) to a server station (14). A wireless connection allows for increased mobility over a wired camera and allows for instantaneous transfer of images to a remote location. Therefore, it would have been obvious to one of ordinary skill in the art to use a cellular modem to transfer the images in Safai wirelessly so that a user is given more mobility when taking images and further so that images can be instantly downloaded to a remote location.

Additionally, neither Safai nor Hull specifically discloses that the content identifier is generated in response to analyzing the digital image file and determining that a predetermined image content is present. Goldberg, on the other hand, discloses that it is well known in the art to identify a person in a picture and then distribute that image to that person. More specifically, Goldberg discloses a method of capturing an image of a person in a public venue, and then allowing the user to collect or distribute those images at their convenience. The system includes

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a camera (63) for capturing an image and facial recognition software for recognizing the person in an image captured using the camera. See page 6, paragraphs 0096-0098. The captured image is then stored in a remote location for retrieval by a user at their convenience. The images can then be selected for emailing to a specific email address. See Figures 13a-c. This feature allows for automated image identification and storage. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to automate the image distribution system of Safai by automatically identifying a person in the image and sending the image to an email account so that a user does not have to personally identify who the image should be sent to, thereby enhancing the operation of the camera.

16. As for *claim 2*, as mentioned above, Safai discloses transmitting the images to a remote service provider (600).

17. **Claims 3, 4, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Safai (U.S. Patent No. 6,715,003) in view of Hull et al. (U.S. Patent No. 5,806,005) and further in view of Goldberg (U.S. Patent No. 2004/0008872).**

18. Regarding *claim 3*, as mentioned above in the discussion of claim 2, Safai, Hull, and Goldberg disclose all of the limitations of the parent claim. However, none of the aforementioned references discloses that the service provider sends a confirmation message to the camera that the transmission has been received. Dong, on the other hand, discloses that it is well known in the art to confirm transmission of an image to another device by sending a confirmation to the device saying that the image has been successfully received. As disclosed in paragraph 0033, Dong discloses that the camera receives a transmission from an external device



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indicating the successful transfer of an image file. This allows the system to know if the image has been successfully received and what actions to take thereafter. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the camera of Safai to receive confirmation from the server so that the camera is informed of the status of the transfer.

19. As for *claim 4*, the transmission would include information.

20. With regard to *claim 6*, Goldberg discloses the ability to recognize the face of the person.

***Allowable Subject Matter***

21. Claim 16 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

22. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 16, the primary reason for allowance is that the prior art fails to teach or reasonably suggest receiving a digital media file over a wireless transmission from the electronic camera, the digital media file having a digital image file and an instruction icon with respect to the digital image file and implementing the instruction associated with the instruction icon with respect to the digital media file by the recipient.

23. Claims 7 and 11-13 allowed. Claim 10 would be allowed if the objection to the claim, mentioned on the preceding pages is overcome

24. The following is an examiner's statement of reasons for allowance:

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Regarding *claim 7*, the primary reason for allowance is that the prior art fails to teach or reasonably suggest that the instruction comprises an icon which identifies a specific instruction that is known to said recipient.

As for *claim 14*, the primary reason for allowance is that the prior art fails to teach or reasonably suggest that the recipient has a computer software program for analyzing the digital image files for recognizing a pre-selected image content having an associated instruction, upon recognizing said image content further processing of said digital image provided by said recipient in accordance with said instruction.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

25. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Villecco whose telephone number is (571) 272-7319. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on (571) 272-7308. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John M. Villecco  
June 20, 2005



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